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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,669	12/31/2003	Donald C. Wood	CLEV:629	2780

27890 7590 11/15/2005  
STEPTOE & JOHNSON LLP  
1330 CONNECTICUT AVENUE, N.W.  
WASHINGTON, DC 20036

EXAMINER
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BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/748,669	WOOD ET AL.	
	Examiner	Art Unit	
	Stephen L. Blau	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2 and 6-26 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 7-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6 and 10-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/10/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 6, 10-16 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 6 and 20 refer to a figure 4 and it is not necessary (See article 2173.05(s) MPEP). In claims 6 and 20 it is not certain what the limits of the claim are. Claims 10-16 are rejected for depending on a rejected base claim.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima in view of Llwelllyn or Wohldorf.

Nakajima (Figs. 1-2) disclose a club having a spherical ball having a hosel bore therein, a shaft in a hosel bore, a grip at the end of a shaft, and club able to perform the function of fitting a desired length for an iron to an individual player in the form of one skilled in the art able to observe how this club with its length fits to a player and giving appropriate recommendations to a player.

Nakajima lacks a fitting system kit with data to fit a length of a club to a player. Llewellyn discloses data to fit a club length to a player (Fig. 4) in order to custom fit a club to a golfer (Abstract). Wohldorf discloses data to fit a club length to a player ([0050], Chart 4). In view of the publications of Llewellyn or Wohldorf it would have been obvious to modify the club of Nakajima to have a fitting system kit with data to fit a length of a club to a player in order to custom fit a club to a golfer.

In an apparatus claim weight is give to what an apparatus is and not how it is used or made. This clubs are able to perform the claimed function.

5. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novosel in view of Llewellyn or Wohldorf.

Novosel (Figs. 1, 4) disclose a club having a spherical ball having a hosel bore therein, a shaft in a hosel bore, a grip at the end of a shaft, and club able to perform the function of fitting a desired length for an iron to an individual player in the form of one skilled in the art able to observe how this club with its length fits to a player and giving appropriate recommendations to a player.

Novosel lacks a fitting system kit with data to fit a length of a club to a player. Llwellyn discloses data to fit a club length to a player (Fig. 4) in order to custom fit a club to a golfer (Abstract). Wohldorf discloses data to fit a club length to a player ([0050], Chart 4). In view of the publications of Llewellyn or Wohldorf it would have been obvious to modify the club of Novosel to have a fitting system kit with data to fit a length of a club to a player in order to custom fit a club to a golfer.

In an apparatus claim weight is give to what an apparatus is and not how it is used or made. This clubs are able to perform the claimed function.

6. Claims 6 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flood in view of Llwellyn or Wohldorf.

Flood discloses a club having a spherical ball with a hosel bore therein, a shaft in a hosel bore, a grip at the end of a shaft (Fig. 4), a club having a length of about 37  $\frac{1}{4}$  and 37  $\frac{1}{2}$  inches in the form of shaft portion (36) being about 34 inches and the terminal portion (40) being about 2 to about 5 inches (Fig. 4, Col. 2, Lns. 58-67), a kit in the form of the parts being separated (Fig. 5) and a club able to perform the function of fitting a desired length for an iron to an individual player in the form of one skilled in the art able to observe how this club with its length fits to a player and giving appropriate recommendations to a player.

Flood lacks a fitting system kit with data to fit a length of a club to a player. Llwellyn discloses data to fit a club length to a player (Fig. 4) in order to custom fit a club to a golfer (Abstract). Wohldorf discloses data to fit a club length to a player ([0050],

Chart 4). In view of the publications of Llewellyn or Wohldorf it would have been obvious to modify the club of Flood to have a fitting system kit with data to fit a length of a club to a player in order to custom fit a club to a golfer.

In an apparatus claim weight is give to what an apparatus is and not how it is used or made. This club is able to perform the claimed function.

7. Claims 6 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yim in view of Llwellyn or Wohldorf.

Yim disclose a club having a spherical ball with a hosel bore therein (Fig. 1), a shaft in a hosel bore, a grip at the end of a shaft (Fig. 3), an exterior surface of a spherical ball comprising a flat surface parallel to an axis of a hosel bore (Abstract, Fig. 1), a kit in the form of the parts being separated (Figs. 1 and 3) and a club able to perform the function of fitting a desired length for an iron to an individual player in the form of one skilled in the art able to observe how this club with its length fits to a player and giving appropriate recommendations to a player.

Yim lacks a fitting system kit with data to fit a length of a club to a player. Llwellyn discloses data to fit a club length to a player (Fig. 4) in order to custom fit a club to a golfer (Abstract). Wohldorf discloses data to fit a club length to a player ([0050], Chart 4). In view of the publications of Llewellyn or Wohldorf it would have been obvious to modify the club of Yim to have a fitting system kit with data to fit a length of a club to a player in order to custom fit a club to a golfer.

In an apparatus claim weight is give to what an apparatus is and not how it is used or made. This club is able to perform the claimed function.

8. Claims 6, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Witherspoon in view of Llwelllyn or Wohldorf.

Witherspoon discloses a club having a spherical ball having a hosel bore therein with the hosel portion extending (17) radially from a ball and the hosel bore being in the extending hosel portion (Fig. 2), a shaft in a hosel bore (Fig. 2), a grip at the end of a shaft (Fig. 1), and a club able to perform the function of fitting a desired length for an iron to an individual player in the form of one skilled in the art able to observe how this club with its length fits to a player and giving appropriate recommendations to a player.

Witherspoon lacks a fitting system kit with data to fit a length of a club to a player. Llwelllyn discloses data to fit a club length to a player (Fig. 4) in order to custom fit a club to a golfer (Abstract). Wohldorf discloses data to fit a club length to a player ([0050], Chart 4). In view of the publications of Llewellyn or Wohldorf it would have been obvious to modify the club of Witherspoon to have a fitting system kit with data to fit a length of a club to a player in order to custom fit a club to a golfer.

In an apparatus claim weight is give to what an apparatus is and not how it is used or made. This club is able to perform the claimed function.

9. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yim in view of Llwellyn or Wohldorf as applied to claims 6 and 12-13 above, and further in view of Witherspoon.

Yim lacks a hosel portion extending substantially radially from a spherical ball. Witherspoon discloses a club having a spherical ball having a hosel bore therein with the hosel portion extending (17) radially from a ball and the hosel bore being in the extending hosel portion (Fig. 2). In view of the patent of Witherspoon it would have been obvious to modify the club of Yim to have a hosel portion extending substantially radially from a spherical ball in order to provide more support to the tip end of the shaft where it is connected to the head.

10. Claims 17, 20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novosel in view of Llwellyn.

Novosel (Figs. 1, 4) disclose a club having a spherical ball having a hosel bore therein, a shaft in a hosel bore, a grip at the end of a shaft, and club able to perform the function of fitting a desired length for a club to an individual player in the form of one skilled in the art able to observe how this club with its length fits to a player and giving appropriate recommendations to a player.

Novosel lacks a fitting system kit with data having LCC, WFM, and PH value ranges as defined by the claims to fit a length of a club to a player. Llwellyn discloses a fitting system kit with data having LCC, WFM, and PH value ranges as defined by the claims fit a club length to a player (Fig. 4) in order to custom fit a club to a golfer



(Abstract). In view of the publication of Llewellyn it would have been obvious to modify the club of Novosel to have a fitting system kit with data having LCC, WFM, and PH value ranges as defined by the claims in order to custom fit a club to a golfer.

11. Claims 17-20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flood in view of Llewellyn.

Flood discloses a club having a spherical ball with a hosel bore therein, a shaft in a hosel bore, a grip at the end of a shaft (Fig. 4), a club having a length of about 37 ¼ and 37 ½ inches in the form of shaft portion (36) being about 34 inches and the terminal portion (40) being about 2 to about 5 inches (Fig. 4, Col. 2, Lns. 58-67), a kit in the form of the parts being separated (Fig. 5) and a club able to perform the function of fitting a desired length for a club to an individual player in the form of one skilled in the art able to observe how this club with its length fits to a player and giving appropriate recommendations to a player.

Flood lacks a fitting system kit with data having LCC, WFM, and PH value ranges as defined by the claims to fit a length of a club to a player. Llewellyn discloses a fitting system kit with data having LCC, WFM, and PH value ranges as defined by the claims fit a club length to a player (Fig. 4) in order to custom fit a club to a golfer (Abstract). In view of the publication of Llewellyn it would have been obvious to modify the club of Flood to have a fitting system kit with data having LCC, WFM, and PH value ranges as defined by the claims in order to custom fit a club to a golfer.

12. Claims 17, 20, 21, and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yim in view of Llwelllyn.

Yim disclose a club having a spherical ball with a hosel bore therein (Fig. 1), a shaft in a hosel bore, a grip at the end of a shaft (Fig. 3), an exterior surface of a spherical ball comprising a flat surface parallel to an axis of a hosel bore (Abstract, Fig. 1), a kit in the form of the parts being separated (Figs. 1 and 3) and a club able to perform the function of fitting a desired length for a club to an individual player in the form of one skilled in the art able to observe how this club with its length fits to a player and giving appropriate recommendations to a player.

Yim lacks a fitting system kit with data having LCC, WFM, and PH value ranges as defined by the claims to fit a length of a club to a player. Llwelllyn discloses a fitting system kit with data having LCC, WFM, and PH value ranges as defined by the claims fit a club length to a player (Fig. 4) in order to custom fit a club to a golfer (Abstract). In view of the publication of Llwelllyn it would have been obvious to modify the club of Yim to have a fitting system kit with data having LCC, WFM, and PH value ranges as defined by the claims in order to custom fit a club to a golfer.

13. Claims 17, 20, 22-23, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Witherspoon in view of Llwelllyn.

Witherspoon discloses a club having a spherical ball having a hosel bore therein with the hosel portion extending (17) radially from a ball and the hosel bore being in the extending hosel portion (Fig. 2), a shaft in a hosel bore (Fig. 2), a grip at the end of a

shaft (Fig. 1), and a club able to perform the function of fitting a desired length for a club to an individual player in the form of one skilled in the art able to observe how this club with its length fits to a player and giving appropriate recommendations to a player.

Witherspoon lacks a fitting system kit with data having LCC, WFM, and PH value ranges as defined by the claims to fit a length of a club to a player. Llewellyn discloses a fitting system kit with data having LCC, WFM, and PH value ranges as defined by the claims fit a club length to a player (Fig. 4) in order to custom fit a club to a golfer (Abstract). In view of the publication of Llewellyn it would have been obvious to modify the club of Witherspoon to have a fitting system kit with data having LCC, WFM, and PH value ranges as defined by the claims in order to custom fit a club to a golfer.

14. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yim in view of Llewellyn as applied to claims 17, 20, 21, and 25-26 above, and further in view of Witherspoon.

See paragraphs above for elements of structure previously rejected by Yim in view of Witherspoon.

### ***Response to Arguments***

15. Applicant's arguments with respect to claim 6 have been considered but are moot in view of the new ground(s) of rejection. Very little weight is giving to the specific data of figure 4 due to the data not being in the claim and due to the claims being an

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apparatus claim for a kit. The data in figure 4 if entered in a method claim would be given weight. However data of figure 4 in a claim for a kit is merely printed matter and the prior art in the rejection show that it is known to use data in form of charts, tables and graphs in fitting a club to a player. The argument that Yim does not have a figure 5 is agreed with. As such the reference has been changed to figures 1 and 3 to show the structure being discussed. This action is not made final due to the new grounds of rejection.

### ***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Blau whose telephone number is (571) 272-4406. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLB/ 13 November 2005



**STEPHEN BLAU**  
**PRIMARY EXAMINER**